IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Randall Frank et al.	Art Unit	: 2143
Serial No.	: 10/728,374	Examiner	: Anish Sikri
Filed	: December 4, 2003	Conf. No.	: 6383
Title	: INTEGRATING MULTIPLE COMMUNICATION MODES		

Mail Stop Appeal Brief - Patents
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REPLY BRIEF

Pursuant to 37 C.F.R. § 41.41, Appellant responds to the Examiner's Answer using the same argument number designations that the examiner used.

(1)

Claim 1 includes the features of: "receiving from a first person a request to converse with a second person using a selected first one of two ... communication modes; and ... automatically performing an action using a second one of the two ... communication modes, selection of the second mode being determined by a rule created by the second person." The examiner argues that: "Loveland disclosed the selection of the second mode being determined by a rule created by the second person."[1] The examiner contends that this feature is met because: "Loveland clearly discloses that the IMR system which controls the rules is configured by a user (Loveland, Col 4 Line 1-5)"[2] and cites to the following passage from Loveland:

> Each user configures a personal IMR system. In a converged network environment, the user is provided access to the IMR through a personal computer interface, web interface, instant message, e-mail, as well as a voice user interface over a telephone connection."[3]

Appellant disagrees. Appellant contends that Loveland neither describes nor would render obvious "automatically performing an action using a second one ... selection of the

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[1] Examiner's Answer, p. 22.
[2] *Id.*
[3] Loveland, col. 4:1-5.

second mode being determined by a rule created by the second person." This conclusion follows because the examiner's argument addresses a feature of "configur[ability]," which is not what is claimed in claim 1. Moreover, while Appellant recognizes that a personal IMR system is configurable, as taught in Loveland, this disclosure of a configurable IMR system fails to teach a "rule created by the second person," let alone "selection of the second mode being determined by a rule created by the second person."

Loveland's IMR system is configured such that the IMR application, not a user, determines the "best method available" for contacting a user:

> In an exemplary configured response scenario the personal IMR application 202 is programmed to route a received instant message to a cell phone or a beeper that accepts text messages, two way pages, or instant messages. In response to the instant message sent to the personal IMR application, the personal IMR determines, by referring to a user status variable and/or a set of configured rules for the recipient, that the intended recipient is likely on a particular cell phone that accepts text messages.[4]

As described in the above passage, "the personal IMR," not the user, determines the device, such as a cell phone or a beeper, to which an instant message is routed. As described in Loveland, the fact that a user may configure rules that are used by the IMR system in determining a response does not result "selection of the second mode being determined by a rule created by the second person".

Indeed, the examiner's reliance on Loveland's disclosure of "configurability" is irrelevant to the teachings of Appellant's claim 1, as illustrated by the following passage from Loveland:

> Through a configuration editor interface, the user specifies a threshold value, including zero, for the number of conference participants to be connected into the phone conference via an internal conference bridge (typically integrated into a PBX system). A configuration editor component of the distributed conference bridge application 204 may incorporate the terminal

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[4] Loveland, col. 13:9-16.

abstraction architecture described herein above. Such a
configuration editor supports user specification of distributed
conference bridge parameter values via graphical and voice user
interfaces.[5]

As described in the above passage, Loveland's disclosure of a "configuration editor" fails to teach "selection of the second mode being determined by a rule created by the second person." Instead, this passage describes that a user can specify the number of "conference participants to be connected in a phone conference." However, not only does this passage fail to disclose any sort of "rule," it also fails to disclose how the communication mode of a telephone conference call is selected. Therefore, the examiner's reasoning that Loveland's teaching of a configurable "personal IMR system" teaches claim 1's limitation of "selection of the second mode being determined by a rule created by the second person" is clearly erroneous.

The examiner further contends that:

> As such the system is configured by the user, then the rule engine which
> attempts to establish communication between two users are indeed
> configured by the user (Loveland, Col 12 Lines 35-60). Therefore Loveland
> disclosed the selection of the second mode being determined by a rule
> created by the second person.[6]

This explanation of how Loveland teaches the feature of "selection of the second mode being determined by a rule created by the second person" is not supported by any reasonable reading of Loveland. For the reasons previously addressed, the Examiner's reliance on "configur[ability]" is misplaced, because Loveland's disclosure of user configured rules fails to teach or suggest "selection of the second mode being determined by a rule created by the second person." As a result, the examiner fails to explicitly show where or how Loveland teaches "selection of the second mode being determined by a rule created by the second person."

The examiner further contends that:

> the motivation to combine Loveland with Tang is valid as Tang does not
> explicitly teach the communication rule is configured by the user, but

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[5] Loveland, col. 13:60-14:2.
[6] Examiner's Answer, p. 22.

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> Loveland does indeed disclose that the communication rule is taught by the
> user (Loveland, Col 4 Lines 1-5). The reference Loveland is brought in to
> overcome the deficiencies which were present in Tang.[7]

The examiner reasons, incorrectly so, that one of ordinary skill in the art would be motivated to combine Tang with Loveland because Tang allegedly teaches some of the limitations of claim 1 and Loveland allegedly teaches the remaining limitations of claim 1. Essentially, the examiner motivation is simple – it is obvious to combine because the two references allegedly teach the features of the claims.

Appellant does not understand how this reasoning explains *why* one of ordinary skill in the art would be motivated to combine Loveland and Tang. That is, the examiner's conclusory statement that Tang teaches some of claim 1's limitations and Loveland teaches the remainder of the limitations fails is not reasoned decision making at least because it fails to add any insight as to *why* one of ordinary skill in the art would be motivated to combine these two references. Rather, it appears to be a clear instance of ex post reasoning which was cautioned against by the Court in KSR.

> [A] patent composed of several elements is not proved obvious merely by
> demonstrating that each of its elements was, independently, known in the prior
> art. Although common sense directs one to look with care at a patent application
> that claims as innovation the combination of two known devices according to
> their established functions, it can be important to identify a reason that would
> have prompted a person of ordinary skill in the relevant field to combine the
> elements in the way the claimed new invention does. This is so because
> inventions in most, if not all, instances rely upon building blocks long since
> uncovered, and claimed discoveries almost of necessity will be combinations of
> what, in some sense, is already known.

See KSR Int'l Co. v. Teleflex Inc., slip op. at 14-15. (Emphasis added.)

Common sense judgment can only lead one to conclude that the Office's conclusion on obviousness is based on impermissible hindsight gleaned entirely from Applicants' disclosure.

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[7] *Id.* at p. 23.

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Although, "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning" the Office is permitted to use "only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure" (*See*, MPEP §2145, X, A.) In fact, this is the type of impermissible hindsight that the Supreme Court warned against in *KSR*.

> A <u>factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning</u>. *See Graham*, 383 U. S., at 36 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "'guard against slipping into the use of hindsight'" (quoting Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co., 332 F. 2d 406, 412 (CA6 1964))). Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.
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> *See KSR Int'l Co. v. Teleflex Inc.*, slip op. at 18 (emphasis added).

The disparate teachings of claim 1's limitations in two different references, without more, is insufficient to produce a motivation to combine, because it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements" as in the claim.[8] Therefore, the examiner's reasoning that claim 1 is rendered obvious by Loveland's alleged teaching of some of claim 1's limitations and Tang's alleged teaching of the remaining limitations is insufficient to produce a motivation to combine. For this reason, the examiner's reasoning regarding a motivation to combine Loveland and Tang is erroneous and should be rejected.

The examiner further contends that because "both the references are within the same environment" that "therefore it would have been obvious to a person skilled in the art to combine the two references."[9] Such reasoning is also insufficient to establish the obviousness of combining Loveland and Tang because "rejections on obviousness cannot be sustained with mere

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[8] *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731 (2007.)
[9] Examiner's Answer, p. 23.

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conclusory statements; instead, there must be some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness."[10] As Appellant argued in the Appeal Brief, the alleged fact that *Loveland* and *Tang* are in the "same environment" does not, without more, produce a motivation to combine. If this was the case then any combination of would be obvious because under the examiner's reasoning all systems are obvious. Accordingly, the examiner has failed to provide any "articulated reasoning" in support of this obviousness rejection.

(2)

The examiner contends that "Loveland does not teach away from the invention, as Loveland disclosed on how different communications can be chosen as stated by the rules). Loveland clearly discloses that the rules are manually created by the user."[11] Appellant stands by the arguments in the Appeal Brief. Appellant further responds that the examiner has mischaracterized Loveland's teachings because in Loveland the IMR system routes communications to a destination partly based on a "rules engine" and partly based on the capabilities of a user's "terminal" or electronic device:

> A rules engine attempts to establish communication between the
> two users via the best method available. For example Person A
> calls Person B. Person B has set the find me status to out of the
> office. Person B's out-of-the-office device is a two-way pager
> capable of receiving pages, e-mail, and instant messages. The IMR
> system attempts to determine the capabilities of Person A's
> terminal either through querying the device directly or asking the
> user interactively through an interactive voice response menu. For
> example if Person A's terminal (a phone) is a phone capable of
> sending instant messages, the IMR will establish an instant
> messaging (IM) session between the two users. If Person A's
> terminal is not capable of sending e-mail or an instant message, the
> IMR will allow Person A to send a numeric page to Person B.[12]

As described in the above passage, it is the IMR system based on the IMR system determining capabilities of Person A's terminal and, not "a rule created by the second person," that chooses the form of communication. Accordingly, the examiner's statement that "Loveland

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[10] *KSR Intern. Co. v.Teleflex, Inc.*, 127 S.Ct. 1727, 1741 (2007).
[11] Examiner's Answer, p. 23.
[12] Loveland, col. 12:45-59.

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disclosed on how different communications can be chosen as stated by the rules" mischaracterizes Loveland.

(3)

The examiner contends:

> Claim 10 is rejected under the combination of Tang- Loveland-Rudy because Rudy discloses on how calendar information is retrieved (Rudy, Col 17 Lines 10-25). And since the claim states it is about retrieving calendar information, the limitation by incorporating Tang-Loveland does not satisfy it clearly until Rudy is presented in combination to clearly state on the retrieval of calendar information. It is obvious to a person skilled in the art to incorporate the use of a calendar to obtain information. The reference Rudy was brought in to further strengthen and clarify the obvious rejection provided by Tang-Loveland (See KSR Decision- MPEP 2143).[13]

The Appellant responds that the examiner has still failed to articulate "with some rational underpinning"[14] why one of ordinary skill in the art would be motivated to combine Rudy, Loveland and Tang. Even assuming arguendo that "[i]t is obvious to a person skilled in the art to incorporate the use of a calendar to obtain information," this fact is only relevant to the obviousness of using "a calendar to obtain information" and fails to provide any explanation as to the obviousness of combining Rudy, Loveland and Tang.

(4)

The examiner contends that "Loveland discloses the rule engine which can be configured by the user in order to be able to create custom communication methods which are presented to the users by the system."[15] Appellant responds that Loveland's alleged teaching of "custom communication methods" produced by a "rules engine" fails to teach claim 1's limitation of "selection of the second mode being determined by a rule created by the second person," because Loveland's IMR system, not a "rule created by the [] person," determines the method of communication, as previously addressed above.

The examiner argues that "Malik in [0075] discloses on how the messages can be transferred to another IM addresses and Malik discloses on how the system checks to see the indicator message indicating

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[13] Examiner's Answer, p. 24.
[14] *KSR Intern. Co. v Teleflex, Inc.*, 127 S.Ct. 1727, 1741 (2007).
[15] Examiner's Answer, p. 26.

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that the current user is away (Malik, [0076] – Malik states that the user is currently unavailable) and the third person is available to converse with the user (Malik in [0075]-[0077])."[16] Appellant responds that the examiner has mischaracterized the Malik reference, because Malik fails to disclose that its system "checks" if the "current user is away." Instead, Malik's auto-forward system sends an "auto-reply" message regardless of the current state of the person who initially received the message or the current state of the person to whom the message is being forwarded.[17]

Additionally, the examiner maintains that "**Malik discloses that the Romeo's presence [sic] is conveyed to Romeo's entire contact list and Romeo's contact list can have many users.**"[18] Appellant responds that Malik's disclosure of conveying presence information to an "entire contact list" is irrelevant to the limitations of claim 12, which requires "wherein automatically performing the action further comprises forwarding the request to converse to a third person if a current status of the second person is that the second person is unavailable to converse and the third person is available to converse." Appellant asserts that the examiner has misinterpreted claim 12's limitations.

Instead of broadcasting a user's presence information to an "entire contact list," claim 12 is directed towards "forwarding a request to converse" if the following conditions have been satisfied: a) "the second person is unavailable to converse;" and b)"the third person is available to converse has misinterpreted the claim language." Broadcasting a user's presence information to an "entire contact list" fails to make any determination as to whether both of these conditions have been met.

The examiner further contends that "**Malik clearly discloses (a) current status of the second person is that the second person is unavailable to converse (Malik, discloses that communication is between three users for example - Romeo, Juliet and Mercutio - Malik [0073].)**"[19] Appellant maintains that Malik's disclosure of "presence logic" fails to teach "forwarding the request to converse to a third person if a current status of the second person is that the second person is unavailable to converse . . ." because in Malik the "presence logic" feature is independent of Malik's "auto-

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[16] Id.
[17] Malik, para. 0076.
[18] Examiner's Answer, p. 26.
[19] Id.

forward" or "auto-reply"[20] features. That is, before Malik's system executes its "auto-forward" or "auto-reply" features, the system never determines that a "second person is unavailable to converse" and that "the third person is available to converse." Instead, the "auto-forward" and "auto-reply" features are automatically executed, independent of the status of a "second" or "third" user.

For at least these reasons, and the reasons stated in the Appeal Brief, Appellant submits that the final rejection should be reversed.

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Respectfully submitted,

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[20] Malik, para. 0076.